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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,958	01/16/2001	Gilbert Dominguez	10323-9004-00	5489
23409	7590	06/16/2004	EXAMINER	
MICHAEL BEST & FRIEDRICH, LLP 100 E WISCONSIN AVENUE MILWAUKEE, WI 53202			SCHLAK, DANIEL K	
			ART UNIT	PAPER NUMBER
			3653	

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/760,958	DOMINGUEZ, GILBERT	
	Examiner	Art Unit	
	Daniel K Schlak	3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-23 is/are pending in the application.
- 4a) Of the above claim(s) 9-14 and 16-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of the restriction into three groups in the reply filed on 3/26/04 is acknowledged. The traversal is on the ground(s) that no serious burden would be placed on the Examiner to examine all three groups. This is not found persuasive because in a broad interpretation of the claims, which must always be used in searching them, the recitations omitted in group I which are present in groups II and III open up the search of group I to myriad collections of art not applicable to groups II and III.

For instance, a reference rejecting claim 1 could, hypothetically, disclose a person sitting on a floor sorting five items into three piles on the floor. Piles 1 and 2 are directly in front of him, and pile 3 sufficiently out of his reach that he is required to get up and walk to pile 3 for placement of items thereon. He notices that two of the items are addressed to A and two to B. He places those of A into pile 1 and those of B into pile 2. The third, he decides whether to stand up to walk the item to pile 3, or to just keep it in his hands because what's the use of the third pile anyway if it only holds one item and he's got to get up to go over to it? His decision is based upon the historical number of items having the same code (zero), the speed of loading rating (more than he wishes to expend), and whether the code is in the scheme he had in mind. In a reasonable interpretation, claim 1 has just been anticipated.

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The Examiner does not pretend to assert that this above is art. However, the potential for the existence of many manual methods, not requiring devices and/or robots, was enough to cause many hours of searching to be performed. Likewise, the absence in groups II and III of the utilization of the speed-of-loading rating in any decision-making process not only renders groups II and III distinct from claim 1, but figuratively pulls the carpet out from under the entire basis of the search performed by the Examiner for group I; namely, that something might or might not get assigned based on the burden to the operator/machine.

Applicant is reminded that, given the large number of references available for sorting wherein control methods are used to decide what to place where, a simple line or two such as "and the speed of loading rating for each location" can have untold consequences in the application of art, perhaps dozens of references being available that depict groups II and/or III that have nothing to do with group I, and vice versa. Thus, as to whether the Examiner would have placed upon him excessive burden in searching three, or two, distinct inventions in the instant application, the Examiner states that adequate time and energy have already been used in searching group I, and to require at this point further search targeted at art *not* disclosing the use of speeds of loading would be to place the burden of the search outside the means which the Examiner finds among his time allocations and reservoirs of energy.

The requirement is still deemed proper and is therefore made FINAL.

Consequently, claims 9-14 and 16-23 have been removed from consideration.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the destination code" in line 6. There is insufficient antecedent basis for this limitation in the claim. More than one code have been mentioned. Which one is discussed here?

Claim 1 recites the limitation "the destination code" in line 7 . There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the item" in line 7. There is insufficient antecedent basis for this limitation in the claim. There are more than one item.

Claim 1 recites the limitation "the destination code" in line 10. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the projected or historical number" in line 11. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the same destination code" in line 12. There is insufficient antecedent basis for this limitation in the claim. The same as what?

Claim 2 recites the limitation "the destination code" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "the destination code" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites the limitation "the destination code" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "the type of container" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "the number of items" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Allowable Subject Matter

Rejections of claims 1-8 under Jones have been removed responsive to the arguments of the Appeal Brief. However, revision of the claims is required to place them in condition for allowance under 35 U.S.C. 112, 2nd Paragraph.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel K Schlak whose telephone number is 703-305-0885. The examiner can normally be reached on Mon-Thurs.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 703-306 - 4173. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

dks


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